

Remarks

Claims 1-2 and 4-11 are pending in the application. Claim 3 has been canceled above without prejudice to or disclaimer of the subject matter therein. Claim 11 is allowed. Claims 1-2, 4-6 and 8-10 stand rejected, and claim 7 is objected to. Favorable reconsideration is respectfully requested.

Claims 1-6, 9 and 10 were rejected under 35 USC 102(b) as being anticipated by Suzuki et al. ("Suzuki") (US 5,558,048). Of these, claim 1, 2, 4-6, 9 and 10 remain pending. To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997).

Accordingly, Suzuki cannot support the asserted rejection for at least the reason that Suzuki does not disclose "an in-block flow passage having a *substantially circular* first opening position on a top face of a cylinder block" (emphasis added).

The Examiner identifies Fig. 9 of Suzuki as disclosing the elements of claim 1. Although the Examiner does not call out specific reference numbers of Fig. 9 in making the rejection, it is assumed for purposes of discussion that it is the Examiner's position that "first passage" 5 corresponds to the claimed in-block flow passage. However, it can be seen in Fig. 9 that first passage 5 does not extend to a top face of cylinder block 3 to form an opening therein. Moreover, even if first passage 5 did extend to the top face of cylinder block 3, it would not form an opening that was circular in cross section, because first passage 5 is part of an annular structure, with second passage 6 forming the other part of the annular structure. Please see Fig. 8C of Suzuki.

Accordingly, Suzuki does not anticipate claim 1. Therefore, claim 1, and claims 2, 4-6, 9 and 10 dependent thereon, are allowable over Suzuki. Withdrawal of the rejection of claims 1, 2, 4-6, 9 and 10 as anticipated by Suzuki is therefore respectfully requested.

Claim 8 was rejected under 35 USC 103(a) as being unpatentable over Suzuki in view of Hiroshi (10159649). To establish a prima facie case of obviousness under § 103, all claim limitations of a claimed invention must be taught or suggested by the prior

art. See MPEP, Section 2143.03 and In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In view of the foregoing authority, the Applicant respectfully submits that the cited references do not support the asserted rejection.

Claim 8 depends on claim 1 and therefore includes its features. Hiroshi is completely silent regarding a groove as claimed. Suzuki actually teaches away from an in-block flow passage as claimed, since Suzuki only discloses an annular in-block structure. Therefore, even the combination of Suzuki and Hiroshi does not suggest a groove in association with an in-block flow passage having a substantially circular first opening position on a top face of a cylinder block. Consequently, claim 8 is allowable over Suzuki and Hiroshi for at least the reasons discussed in the foregoing. Withdrawal of the rejection of claim 8 as being unpatentable over Suzuki in view of Hiroshi is therefore respectfully requested.

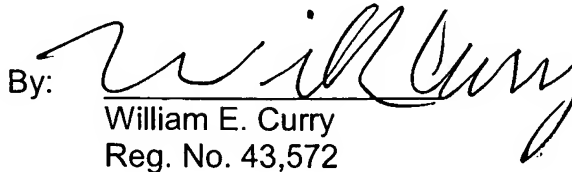
Claim 7 was objected to, but was indicated to be allowable if rewritten in independent form. Accordingly, claim 7 has been so rewritten, and is allowable. Withdrawal of the objection to claim 7 is therefore respectfully requested.

In light of the above discussion, Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

Dated: DEC. 29, 2004

By: 
William E. Curry
Reg. No. 43,572

KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201